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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/837,009 04/11/97 BELL

G 2300.0202

HM22/0226

EXAMINER

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SAOUD, C

ART UNIT

PAPER NUMBER

1647

DATE MAILED:

02/26/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
08/837,009

Applicant(s)  
BELL et al.

Examiner  
Christine J. Saoud

Group Art Unit  
1647



☒ Responsive to communication(s) filed on Nov 27, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-49 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-49 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

## **DETAILED ACTION**

### ***Request for Continued Examination***

1. A request for continued examination under 37 CFR 1.114 was filed in this application after appeal to the Board of Patent Appeals and Interferences, but prior to a decision on the appeal. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 27 November 2000 has been entered.

### ***Oath/Declaration***

2. The reissue oath/declaration filed with this application is defective because it fails to contain a statement that "all errors which are being corrected in the reissue application up to the time of filing of the oath/declaration" arose without any deceptive intention on the part of the applicant. See 37 CFR 1.175 and MPEP § 1414.

3. Claims 1-49 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the declaration was set forth in the previous Office action. Applicant's acknowledgment of the rejection is noted, but does not overcome the rejection because a new declaration has not yet been received.

*Claim Objections*

4. Claim 8 has been improperly amended in that a left bracket has been omitted. It is not clear what subject matter is being deleted from the claim.

Claims 23-28, 31-35, 42-43, 46 contain redundant material, which could be deleted. The redundant material is the reference to the amino acid sequence of the polypeptide. In each of the claims, a specific nucleic acid is required, therefore, the amino acid sequence encoded by the nucleic acid is inherent. The additional verbiage only serves to confuse the reader, as well as lengthen the claims. For example, claim 23 could be written: "A method of producing a polypeptide in a suitable host cell transformed with a polynucleotide encoding said polypeptide wherein said polynucleotide comprises a nucleic acid sequence selected from the group consisting of the nucleic acid sequences of claims 2 and 3." Claim 24 could be written: "A method of producing a polypeptide comprising introducing into a suitable host cell a nucleic acid molecule comprising a polynucleotide encoding said polypeptide, wherein said polynucleotide comprises a nucleic acid sequence selected from the group consisting of the nucleic acid sequences of claims 2 and 3."

Claim 44 recites a vector comprising a nucleic acid sequence selected from the group consisting of (a), (b), (c), (d) and (e) of claim 1. Since these are all elements of claim 1, it would be more expedient to recite "A vector comprising a nucleic acid sequence of claim 1." Claim 45 would still be properly dependent.

***Double Patenting***

5. Claims 23 and 25-28 are objected to under 37 CFR 1.75 as being a substantial duplicate of claims 31-35, respectively. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

In the instant situation, although claims 23 and 25-28 do not specifically recite that the nucleic acid molecule is DNA (which is recited in claims 31-35), these claims would necessarily need to be directed to DNA in order to produce the protein. Therefore, the claims are directed to the same subject matter and are substantially duplicative of one another. If Applicant is aware of a method of producing a protein by transforming a host cell with RNA, the objection will be withdrawn.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 8 and dependent claims 9-17, claims 25-26 and 46-48 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 8 is missing a left bracket. Therefore, it is not clear what subject matter is to be excluded from the claim, making the metes and bounds of the claim unclear and indefinite.

Claims 25 and 26 recite different proteins but recite the same nucleic acid sequence (b). Therefore, it is not clear which nucleic acid encodes which IGF molecule. It would appear that claim 25 should be directed to sequence (a). Appropriate correction is necessary in order to interpret the claimed subject matter.

Claim 46 is indefinite and unclear because there is no antecedent basis for the nucleic acid sequences of (a), (b) and (d). It would appear that this claim should depend from claim 44 or from claim 1. If this is the case, the claim should be reworded as “an expression vector comprising a polynucleotide according to claim 1, wherein said polynucleotide comprises a nucleic acid sequence selected from the group consisting of the nucleic acid sequences of (a), (b) and (d).

Claim 47-48 are unclear and indefinite because there is no antecedent basis for “said amino acid sequence” of IGF-I or II. Again, as noted above, the claimed subject matter relies on the nucleic acid molecules which encode the proteins. Therefore, reference to the nucleic acids which encode the protein is sufficient to inherently encode for IGF-I or II. The claims could be written as “An expressing vector according to claim 46, wherein said nucleic acid sequence is (a)” or “(b)”. Note, claim 46 must be amended as suggested above for this to make sense.

### ***Conclusion***

8. No claim is allowed.

Applicant's statement at the end of the response regarding contacting the attorney if there are any outstanding issues or questions is noted. Applicant should note that the above Office action is intended to be a complete review of all the remaining issues in the instant application. It is also noted that the Examiner is not permitted to amend the claims via an Examiner's Amendment unless the amendment will place the instant application into condition for allowance. In view of the outstanding issue of the requirement for a new Declaration, the claims would not be in condition for allowance until such is submitted. It is also noted that a new Declaration cannot be submitted until the claims are in their final form (due to the instant application being a reissue application). The Examiner feels that if the above issues are addressed and the claims are amended as suggested, Applicant will be in a position to provide the new Declaration and the application would be in condition for allowance upon response to the instant Office action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christine Saoud, Ph.D., whose telephone number is (703) 305-7519. The examiner can normally be reached on Monday to Friday from 7AM to 3PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz, can be reached on (703) 308-4623.

Certain papers related to this application may be submitted to Technology Center 1600 by facsimile transmission. Papers should be faxed to Technology Center 1600 via the PTO Fax Center located in Crystal Mall 1 (CM1). The faxing of such papers must conform with the notices published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993) (see 37 C.F.R. § 1.6(d)). NOTE: If Applicant *does* submit a paper by fax, the original signed copy should be retained by Applicant or Applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED so as to avoid the processing of duplicate papers.

Official papers filed by fax should be directed to (703) 308-4556. If this number is out of service, please call the Group receptionist for an alternate number. Faxed draft or informal

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communications with the examiner should be directed to (703) 308-0294. Official papers should NOT be faxed to 308-0294.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

February 26, 2001

**CHRISTINE J. SAUD**  
**PRIMARY EXAMINER**

*Christine J. Saud*